

## **REMARKS**

### ***Summary of Office Action***

In the Office Action, the Examiner rejected claims 1 and 20 under 35 U.S.C. § 101 for allegedly being directed to non-statutory subject matter. In particular, the Examiner submitted that the process must be tied to another statutory class or transform underlying subject matter to a different state or thing. However, the Examiner helpfully provided that explicitly claiming the medium or structure in the body of the claim that performs the underlying process steps would serve to better recite the technological arts within the present set of claims. Furthermore, the Examiner graciously concluded that claims 1, 3-7, 11, 14, 16-20, 26-33, and 35-37 distinguish over the prior art and would be allowable upon overcoming the non-statutory subject matter rejection. Additionally, the Examiner stated that Applicant needs to further amend the claims to have a computer perform the other method steps recited within the claims. No other issues were presented.

### ***Summary of Amendments***

Upon entry of the present Response to Office Action, claims 1 and 20 will have been amended. As such, claims 1, 3-7, 11, 14, 16-20, 26, 28-33, and 35-37 remain currently pending. By the present amendment, Applicant submits that the rejections have been overcome and respectfully requests reconsideration of the outstanding Office Action.

*Applicant's Response*

1. Section 101 Rejection of Claims 1 and 20

Applicant's independent claim 1 as currently amended recites, inter alia, "...evaluating said data submitted in step (ii) via a computer capable of interpreting said electronic medical records ... electronically submitting only a single CPT code corresponding to a single, specified medical service to be rendered in response to the clinical event specified in step (c) via a data communications network ... electronically responding to said submission made in step (d) based upon said evaluation made in step (e), said response comprising either approval or disapproval to proceed with rendering the requested service corresponding to said code submitted in step (d) via a data communications network ...". Similarly, Applicant's independent claim 20 as currently amended recites, the same language.

Applicant respectfully submits that the current amendments overcome the 35 U.S.C. § 101 rejection and place the claims in condition for allowance, at least for the reason that the claimed methods now explicitly require the use of technological arts, in that multiple steps are performed electronically and/or by a computer. As the Examiner indicated in the Office Action (See Page 6, Paragraph Number 10), "Applicant needs to further amend the claims to have a computer perform the other method steps recited within the claims." Applicant respectfully submits that the currently amended claims meet the requirement set forth by the Examiner.

As is well known, a claim reciting an abstract idea can state statutory subject matter only if, "it is embodied in, operates on, transforms, or otherwise involves another class of statutory subject matter, i.e., a machine." *In re Comiskey*, 84 USPQ2d 1670, 1678 (Fed. Cir. 2007). Along these lines, the Federal Circuit recently reiterated this line of thinking in *In re Bilski*, wherein the court stated that "a claimed process is surely patent-eligible under §101 if:

(1) it is tied to a particular machine *or* apparatus, or (2) it transforms a particular article into a different state or thing.” 88 USPQ2d 1385, 1391 (Fed. Cir. 2008).

In the current situation, after having been amended, the claims now recite that the information received from patients are stored in electronic medical records embodied on a computer readable medium, the medical records are evaluated by a computer, and information is electronically submitted and responded to via a data communications network. The currently amended claims thus are tied to a particular machine. As such, Applicant respectfully submits that the claims now are in condition for allowance and requests that the 35 U.S.C. § 101 rejection be withdrawn.

In conclusion, Applicant respectfully submits that the claims, as currently amended, are sufficiently tied to statutory matter so as to overcome any 35 U.S.C. § 101 rejection. Furthermore, Applicant appreciates the Examiner’s indication that Applicant’s claims distinguish over the prior art and are allowable but-for the § 101 rejection, which Applicant respectfully submits has been overcome by the present amendments and above arguments.

***Conclusion***

Applicant respectfully submits that each and every pending claim of the present invention meets the requirements for patentability under 35 U.S.C. §§ 101, 112, 102, and 103, and respectfully requests that the Examiner indicate allowance of each and every pending claim of the present invention.

In view of the foregoing, it is submitted that each of claims 1, 3-7, 11, 14, 16-20, 26, 28-33, and 35-37 are now properly and sufficiently tied to statutory subject matter.

Accordingly, reconsideration of the outstanding Office Action and allowance of the present application and all the claims therein are respectfully requested and now believed to be appropriate.

If any additional fee is required, please charge Deposit Account Number 19-4330.

Respectfully submitted,

Date: 6-17-09

By:



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